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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,859	08/23/2001	Masahiko Enari	09812.0651	9497
22852 7590 02/12/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER REFAI, RAMSEY	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 02/12/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/935,859

Applicant(s)

ENARI, MASAHIKO

Examiner

RAMSEY REFAI

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Responsive to Request for Continued Examination (RCE) filed January 23, 2008. Claims 6 and 10 have been amended. Claims 6-13 remain pending.

Response to Arguments

1. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, the Applicant argues with substance:

Argument A: *Rautila does not teach the identification code corresponds only to the electronic content item.*

In response, the Examiner respectfully disagrees. After the user selects a particular digital product desired from among the titles available on the electronic shop server (column 6, lines 1-8), the user receives a unique order number, which corresponds to the selected digital product (column 9, lines 60-63, column 6, lines 1-8 and 35-38). The unique order number is used to obtain the desired digital product from the electronic shop server which meets the limitation of "an identification code corresponds only to the electronic content item". Therefore Rautila meets the scope of the claimed limitation.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 6-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 6 and 10 have been amended to include the features " *wherein the identification code corresponds only to the electronic content item*" and " *enabling the customer to view physical commodities...at the store terminal*" which appear to lack proper support in the disclosure.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

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subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rautila (US Patent No. 6,714,797).

6. As per claim 6, Rautila teach a method for providing electronic content to a customer using a remote user terminal and a store information terminal, the method comprising the steps of:

accessing a menu including a plurality of electronic content items available for purchase using the remote user terminal (column 6, lines 2-7);

selecting an electronic content item using the remote user terminal (column 6, lines 5-7);

obtaining an identification code, via a first communication channel (column 6, line 1; internet 150), for individually identifying the retrieved electronic content item (column 6, line 35-40, column 8, lines 31-37); wherein the identification code corresponds to the electronic content item (column 9, lines 60-63, column 6, lines 1-8 and 35-38);

inputting the identification code at the store information terminal (column 6, lines 50-53);

enabling the customer to purchase (column 6, lines 53-64), via a second communication channel, the second communication channel being different from the first communication channel (hotspot network 50), the retrieved electronic content item corresponding to the identification code (column 6, lines 50-64),; and

enabling the customer to download the electronic content item (column 6, line 53-column 7, line 5); and

enabling the customer to view *commodities* or services that are available for purchase (column 6, lines 2-7) in addition to the electronic content items at the store information terminal (column 5, lines 45-60).

Although Rautila teaches that a hotspot network location can be in a shopping mall, department store, video store, etc (column 4, lines 64-67) and that advertisements are transmitted to the mobile device to solicit further purchases (column 6, lines 64-67), Rautila fails to teach enabling the customer to view *physical commodities* in addition to the electronic content item that are available for purchase. However, it would have been obvious to one of ordinary skill in the art to transmit advertisements to the mobile device for physical products available at the hotspot location (i.e. available at the shopping mall or store) in order to promote sales.

7. As per claim 7, Rautila teaches downloading the electronic content item to a portable recording medium (column 4, lines 15-25; downloading content to mobile station 10).

8. As per claim 8, Rautila teaches wherein the menu including the plurality of electronic content items available for purchase is located on a server accessible by the remote user terminal via a network (column 6, lines 2-8).

9. As per claim 9, Rautila teaches wherein the step of obtaining the identification code comprises downloading the identification code to a portable recording medium (**column 6, lines 35-38; unique order number downloaded to mobile station 10**).

10. As per claims 10-13, these claims contain similar limitations as claims 6-9 above, therefore are rejected under the same rationale.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMSEY REFAI whose telephone number is (571)272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.